DOCKET NO: 294227US0X PCT

### IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

: ATTN: APPLICATION DIVISION HARALD GROEGER, ET AL.

SERIAL NO: 10/593,567

FILED: SEPTEMBER 20, 2006

FOR: PROCESS FOR PREPARING

OPTICALLY ACTIVE AMINO ACIDS USING

A WHOLE-CELL CATALYST

### PETITION UNDER 37 C.F.R. §1.47(A)

COMMISSIONER FOR PATENTS ALEXANDRIA, VIRGINIA 22313

SIR:

The undersigned Petitioners hereby request that the executed oath/declaration under 37 C.F.R. §1.63 submitted herewith be accepted in lieu of the fact that Prof. Werner Hummel, who is a named inventor on the above-identified application, refuses to sign the oath/declaration after numerous diligent and bona fide attempts have been made to obtain the signature thereof. Evidence substantiating these unsuccessful attempts, which have in fact been made to obtain a properly executed oath/declaration from Prof. Werner Hummel, are summarized in detail in the following "Statement of Facts," as attested to and executed by Ms. Sandra Wissel.

#### STATEMENT OF FACTS

On three separate occasions, Ms. Sandra Wissel mailed a copy of the enclosed oath/declaration to Prof. Werner Hummel, along with the enclosed accompanying letters dated August 22, 2006, October 2, 2006, and December 8, 2006. Successful delivery of the mailings of October 2, 2006, and December 8, 2006, are substantiated by the enclosed evidentiary mail return receipts with corresponding signature confirmation confirming receipt and acceptance of the oath/declaration by Prof. Werner Hummel.

Application No. 10/593,567 Attorney Docket No. 294227US Petition under 37 C.F.R. §1.47(a)

Although I have made numerous diligent and *bona fide* attempts to obtain a properly executed oath/declaration from Prof. Werner Hummel, as of the date that this Statement of Facts was executed, a duly executed oath/declaration has not been received from Prof. Werner Hummel.

I declare under penalty of perjury under the laws of the United States that the foregoing is true

Mr. Candra Wiccel

and correct.

June 20, 2007

The refusal of Prof. Werner Hummel to duly execute the oath/declaration is evidenced by the forgoing diligent and *bona fide* attempts made by Ms. Sandra Wissel to obtain the signature thereof. It is readily apparent that Prof. Werner Hummel refuses to duly execute the oath/declaration, as substantiated by the enclosed evidentiary mail return receipts with corresponding delivery/signature confirmation, which confirm receipt and acceptance of the oath/declaration by Prof. Werner Hummel.

In accordance with 37 C.F.R. §1.47(a), enclosed herewith is the fee set forth in 37 C.F.R. §1.17(g), an executed Statement of Facts averring to the foregoing diligent and *bona fide* attempts made by Ms. Sandra Wissel to obtain a properly executed oath/declaration from Prof. Werner Hummel, accompanying documentary evidence substantiating these efforts, and an oath/declaration under 37 C.F.R. §1.63, which has been executed by the named inventors on the above-identified application, except for Prof. Werner Hummel, who refuses to sign.

Consequently, it is respectfully requested that this petition be GRANTED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C.

Richard L. Treanor Attorney of Record Registration No. 36,379

David P. Stitzel Attorney of Record Registration No. 44,360

Customer Number 22850

Tel: (703) 413-3000 Fax: (703) 413 -2220 (OSMMN 06/04)

## creating essentials

Degussa AG • P.O.Box 1345 • 63403 Hanau • Germany

Herrn Professor Werner Hummel Claudiusstrasse 11

52445 Titz GERMANY

Unser Zeichen 200410021 (früher: 040055 AM) Verfahren zur Herstellung von optisch aktiven Aminosäuren mi ttels eines Ganzzellkatalysators Validierung zur PCT-Patentanmeldung PCT/EP2005/002933

Sehr geehrter Herr Professor Hummel,

zu Ihrer Information möchten wir Ihnen mitteilen, dass wir obige PCT-Anmeldung in folgenden Staaten validieren werden:

CA, CN, JP, US; EP

Wir bitten Sie, die beigefügten Formulare an den angekreuzten Stellen zu unterzeichnen und zu datieren (bitte in US-Schreibweise – MM/TT/JJJJ) und

innerhalb von zwei Wochen

an

Degussa AG S-IPM-PAT Postcode 84/339 Rodenbacher Chaussee 4 63457 Hanau DEUTSCHLAND

zurückzusenden.

Bitte lassen Sie auf dem Assignment für Canada zusätzlich einen **Zeugen** unterschreiben. Zeuge kann hierbei **jede** volljährige Person sein.

Degussa AG Rodenbacher Chaussee 4 63457 Hanau DEUTSCHLAND

T +49-6181-59-01 F +49-6181-59-3030

www.degussa.com

22.Aug.2006

Kontakt: Sandra Wissel

Degussa AG Intellectual Property Management PATENTE & MARKEN Standort Hanau

S-IPM-PAT Unser Zeichen: 200410021

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ipm\_pat\_hanau@degussa.com

Degussa AG • Sitz: Düsseldorf • Aufsichtsratsvorsitzender: Dr. Werner Müller • Vorstand: Prof. Dr. Utz-Hellmuth Felcht (Vorsitzender), Dr. Bernhard Hofmann, Dr. Alfred Oberholz, Dr. Thomas Schoeneberg, Dr. Manfred Spindler, Heinz-Joachim Wagner Amtsgericht Düsseldorf, HRB 39635 • Commerzbank AG, Düsseldorf, BLZ 300 400 00, Konto 1353010 • Degussa Bank GmbH, Frankfurt a. M., BLZ 500 107 00, Konto 390000 • Deutsche Bank AG, Düsseldorf, BLZ 300 700 10, Konto 3941820 • Dresdner Bank AG, Düsseldorf, BLZ 300 800 00, Konto 2121220

Besten Dank im Voraus.

Seite 02

Mit freundlichen Grüßen Degussa AG

gez. Dr. Stefan Retzow

gez. SandraWissel

Dieses Schreiben wurde vollautomatisch erstellt. Der Inhalt ist auch ohne Unterschrift verbindlich

<u>Anlagen</u>

CA-Assignment-Formular US-Declaration-Formular US-Assignment-Formular PCT-Veröffentlichung

[Letter from Degussa AG, Hanau, Germany, to Professor Werner Hummel, Titz, Germany, dated 22 August 2006]

Our reference 200410021 (previously: 040055 AM)

Process for preparing optically active amino acids using a whole-cell catalyst Validation for PCT patent application PCT/EP2005/002933

Dear Professor Hummel,

We are writing to inform you that we are going to validate the abovementioned PCT application in the following states:

CA, CN, JP, US; EP

We would ask you to sign and date the attached forms at the places marked with a cross (please date in the US style – MM/DD/YYYY) and return them

within two weeks

to

Degussa AG S-IPM-PAT Postcode 84/339 Rodenbacher Chaussee 4 63457 Hanau GERMANY.

Please arrange for a witness to also sign the assignment for Canada. Witnesses can be any person of full age.

Many thanks in advance.

Yours sincerely

Degussa AG

signed Dr Stefan Retzow

signed Sandra Wissel

This letter was produced automatically and is valid even unsigned.

# Enclosures

CA Assignment Form
US Declaration Form
US Assignment Form
PCT Publication

## creating essentials

Degussa AG, Postfach 1345, 63403 Hanau

Einschreiben mit Rückschein

Herrn Professor Werner Hummel Claudiusstrasse 11

52445 Titz GERMANY

Unser Zeichen 200410021 (früher: 040055 AM) Verfahren zur Herstellung von optisch aktiven Aminosäuren mittels eines Ganzzellkatalysators

Sehr geehrter Herr Professor Hummel,

die erbetene Stellungnahme/Zusendung von Unterlagen liegt noch nicht vor.

Zur Vermeidung von unnötigen Kosten möchten wie Sie dringend bitten, die erbetene Stellungnahme/Zusendung nunmehr

innerhalb von zwei Wochen

an

Degussa AG S-IPM-PAT Postcode 84/339 Rodenbacher Chaussee 4 63457 Hanau DEUTSCHLAND

zurückzusenden.

Mit freundlichen Grüßen **Degussa AG** 

Dieses Schreiben wurde vollautomatisch erstellt. Der Inhalt ist auch ohne Unterschrift verbindlich.

<u>Anlagen</u>

Kopie unseres Schreibens vom 22.08.06 samt Anlagen

Degussa AG Rodenbacher Chaussee 4 63457 Hanau DEUTSCHLAND

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www.degussa.com

02.Oct.2006

Kontakt: Sandra Wissel

Degussa AG Intellectual Property Management PATENTE & MARKEN Standort Hanau

S-IPM-PAT Unser Zeichen: 200410021

T +49 6181-59-2016 F +49 6181-59-4304

ipm\_pat\_hanau@degussa.com

[Registered letter with advice of delivery from Degussa AG, Hanau, Germany, to Professor Werner Hummel, Titz, Germany, dated 2 October 2006]

Our reference 200410021 (previously: 040055 AM)

Process for preparing optically active amino acids using a whole-cell catalyst

Dear Professor Hummel,

We have still not received the statement/documents requested.

To avoid unnecessary expenses, we would urge you to return the statement/documents requested

within two weeks

to

Degussa AG S-IPM-PAT Postcode 84/339 Rodenbacher Chaussee 4 63457 Hanau GERMANY.

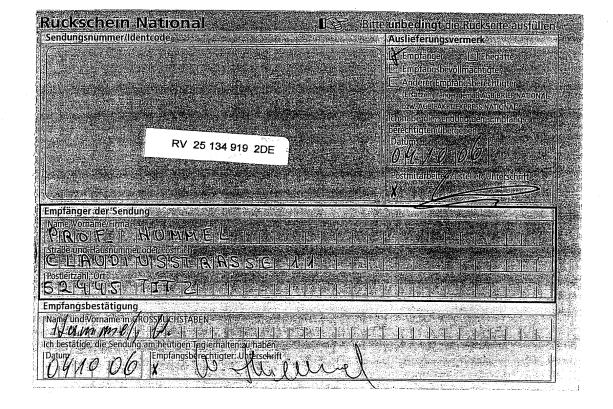
Yours sincerely
Degussa AG

This letter was produced automatically and is valid even unsigned.

**Enclosures** 

Copy of our letter of 22.08.06 including enclosures





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National Recorded Delivery Form

Remember to include your address

Dear Customer,

Please fill in your full address on the right.

Please return to:

Degussa AG

Surname

Please also complete the following boxes

Patent Department (Wissel)

Forename

"Addressee"

overleaf:

Rodenbacher Chaussee 4

• "Consignment No./Ident code" if applicable

Street and house number or PO box

63457 Hanau

Post code, town

Received by
Intellectual Property
Management
06 OCT, 2006

Location Wolfgang

National Recorded Delivery Form Consignment No./Ident code

The reverse must be completed

Delivery note

☑ Addressee

□ Spouse

□ Authorized representative

☐ Other authorized recipient

(Substitute recipient according to NATIONAL LETTER

or NATIONAL PACKET/EXPRESS terms)

I have handed over the consignment to the

authorized recipient.

Date

04.10.06

Post office employee: Signature

X [signed]

RV 25 134 919 2DE

### Addressee

Surname, forename/company name PROF. HUMMEL
Street and house number or PO box CLAUDIUSSTRASSE 11
Post code, town
52445 TITZ

### Acknowledgment of receipt

Surname and forename in CAPITAL LETTERS

Hummel, W.

I confirm that I have received the consignment today.

Date

04.10.06

Authorized representative: Signature

X W. Hummel

## creating essentials

Degussa AG, Postfach 1345, 63403 Hanau

Einschreiben mit Rückschein

Herrn Professor Werner Hummel Claudiusstrasse 11

52445 Titz GERMANY

Unser Zeichen 200410021 (früher: 040055 AM) Verfahren zur Herstellung von optisch aktiven Aminosäuren mittels eines Ganzzellkatalysators

Sehr geehrter Herr Professor Hummel,

wir kommen zurück auf unsere Schreiben an Sie vom 22. August 2006 sowie unsere Erinnerung vom 2. Oktober 2006.

die erbetene Zusendung von der unterzeichneten Unterlagen liegt uns noch immer nicht vor.

Zur Vermeidung von unnötigen Kosten sowie Vermeidung eines Rechtsverlustes möchten wie Sie dringend bitten, die erbetenen unterzeichneten Formulare nunmehr

#### umgehend

an

Degussa AG S-IPM-PAT Postcode 84/339 Rodenbacher Chaussee 4 63457 Hanau DEUTSCHLAND

zurückzusenden.

Mit freundlichen Grüßen Degussa AG

Dieses Schreiben wurde vollautomatisch erstellt. Der Inhalt ist auch ohne Unterschrift verbindlich.

<u>Anlagen:</u> Kopie unseres Schreibens vom 22.08.06 samt Anlagen + Kopie Erinnerung vom 02.10.2006

Degussa AG Rodenbacher Chaussee 4 63457 Hanau DEUTSCHLAND

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www.degussa.com

08.Dez.2006

Kontakt: Sandra Wissel

Degussa AG Intellectual Property Management PATENTE & MARKEN Standort Hanau

S-IPM-PAT Unser Zeichen: 200410021

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ipm\_pat\_hanau@degussa.com

[Registered letter with advice of delivery from Degussa AG, Hanau, Germany, to Professor Werner Hummel, Titz, Germany, dated 8 December 2006]

Our reference 200410021 (previously: 040055 AM)
Process for preparing optically active amino acids using a whole-cell catalyst

Dear Professor Hummel,

We refer to our letter to you dated 22 August 2006 and our reminder dated 2 October 2006.

We have still not received the signed documents requested.

To avoid unnecessary expenses and loss of a right, we would urge you to return the signed forms requested

### without delay

to

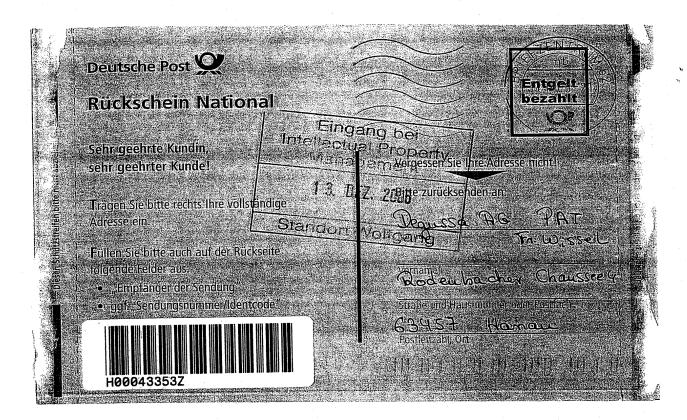
Degussa AG S-IPM-PAT Postcode 84/339 Rodenbacher Chaussee 4 63457 Hanau GERMANY.

Yours sincerely

Degussa AG

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Enclosures: Copy of our letter of 22.08.06 including enclosures + copy of reminder of 02.10.2006



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Dear Customer,

Please fill in your full address on the right.

Please return to:

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Surname

Please also complete the following boxes

Mrs Wissel

overleaf:

Forename

"Addressee"

"Consignment No./Ident code" if applicable

Rodenbacher Chaussee 4

Street and house number or PO box

[bar code] H00043353Z

63457 Hanau

Post code, town

Received by

Intellectual Property

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Location Wolfgang

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The reverse must be completed

Delivery note

☑ Addressee

□ Spouse

Authorized representative

□ Other authorized recipient

(Substitute recipient according to NATIONAL LETTER

or NATIONAL PACKET/EXPRESS terms)

I have handed over the consignment to the

authorized recipient.

Date

09.12.06

Post office employee: Signature

X [signed]

#### Addressee

Surname, forename/company name
PROFESSOR HUMMEL
Street and house number or PO box
CLAUDIUSSTRASSE 11
Post code, town
52445 TITZ

## Acknowledgment of receipt

Surname and forename in CAPITAL LETTERS

Hummel, W.

I confirm that I have received the consignment today.

Date

09.12.06

Authorized representative: Signature

X [signed]